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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,624	10/09/2001	Alfred T. Tabayoyon JR.	SWIF 2123	8468
7812	7590	11/19/2004	EXAMINER	
SMITH-HILL AND BEDELL 12670 N W BARNES ROAD SUITE 104 PORTLAND, OR 97229			AVELLINO, JOSEPH E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,624

Applicant(s)

TABAYOYON ET AL.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-22 are presented for examination; claims 1 and 14 independent.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-8, 13-17, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by McMillan (USPN 6,789,108).

3. Referring to claim 1, McMillan discloses a method for transmitting a document file describing a document from a sender computer 25 to a receiver computer 25 via a computer network 16 linking the sender computer and the receiver computer to a server computer 12-15, wherein the sender computer is operated by a sender, wherein the receiver computer is operated by a receiver, the method comprising the steps of:
 - a. transmitting the document file from the sender computer to the server computer via the computer network (Figure 10, 321; col. 8, lines 3-16);

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- b. transmitting the document file (i.e. email) from the server computer to the receiver computer via the computer network (Figure 11, 330; col. 8, lines 17-48);
 - c. providing viewer software (col. 3, lines 45-60; col. 4, lines 55-59) executed by the receiver computer for generating a display of an image of the document (i.e. flash file or the like) described by the document file (i.e. email) when received by the receiver computer (col. 7, line 58 to col. 8, line 2), and for thereafter automatically returning verification data to the server computer via the computer network verifying that the receiver computer has successfully displayed the document image (Figure 12, 340; col. 8, line 49 to col. 9, line 52).
- 4. Referring to claim 2, McMillan discloses further comprising the steps of:
 - d. storing log data (i.e. tracking software) on the server computer indicating when the receiver computer returned the verification data to the server computer (Figure 13, 410; col. 9, line 15-52); and
 - e. providing the sender computer with access to the log data via the computer network (col. 10, lines 38-54).
- 5. Referring to claim 4, McMillan discloses further comprising the steps of:
 - d. transmitting a publish request from the sender computer to the server computer wherein the publish request identifies the receiver computer (col. 8, lines 3-16); and

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- e. prior to step b, transmitting an email message generated by the sender from the server computer to the receiver computer identified in the publish request, wherein the email message references the document file (col. 8, lines 3-16).
- 6. Referring to claim 5, McMillan discloses further comprising the steps of:
 - f. prior to step e, storing the document file in the server computer and assigning a network address to the document file stored on the server computer (it is an inherent feature that whenever a file is stored onto a computer, it is assigned a unique file address, otherwise there will be no way in accessing the file) (col. 7, lines 3-27), wherein the email message transmitted at step e includes a reference to the assigned network address (col. 7, lines 59-67).
- 7. Referring to claim 6, McMillan discloses the reference to the assigned network address is a hypertext link included in the email message (i.e. a standard email message) (col. 7, lines 59-67).
- 8. Claim 7 is rejected for similar reasons as stated above.
- 9. Referring to claim 8, McMillan discloses wherein step b comprises the sub-steps of:

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- b1. verifying that the receiver is signed on to the server computer (i.e. password and username to the email account (Figure 13, 410; col. 9, lines 15-53, parameters i and j); and
- b2. thereafter transmitting the document file from the server computer to the receiver computer via the computer network (col. 8, lines 17-48).

10. Referring to claim 13, McMillan discloses the receiver computer returns the verification data to the server computer as an encoded network address (col. 9, lines 15-52).

11. Claims 14-17, and 21 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9, 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan in view of Ohashi (USPN 6,209,030).

14. Referring to claim 9, McMillan discloses the invention substantively as described in claim 1. McMillan further discloses transmitting a publish request from the sender computer to the server computer, wherein the publish request identifies the receiver computer, and transmitting the document file from the sender computer to the server computer via the computer network (see claims above). McMillan does not specifically disclose the publish request indicated that the receiver computer is to be prevented from printing the document file. In analogous art, Ohashi discloses another method of transmitting document files from a sender to a receiver wherein the publish request (i.e. tag information) is that the receiver computer is to be prevented from printing the document file (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ohashi with McMillan since McMillan discloses that other encapsulation packages can be used (wherein the term "encapsulation" is taken as bundling the information for distribution in various entities) (col. 4, lines 45-48). This would lead one of ordinary skill in the art to search for other encapsulation means which would lead one to Ohashi and a secure encapsulation

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of HTML files such that hard copying of files is denied, thereby reducing the tendencies of unauthorized users obtaining classified or internal information as supported by Ohashi (col. 2, lines 10-18).

15. Referring to claim 10, McMillan discloses the invention substantively as described in claim 9. McMillan further discloses transmitting the document file from the server computer to the receiver computer via the computer network (see claim rejections above). McMillan does not specifically disclose preventing the receiver computer from printing the document file. In analogous art, Ohashi discloses another method of transmitting document files from a sender to a receiver which prevents the receiver computer from printing the document file (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ohashi with McMillan since McMillan discloses that other encapsulation packages can be used (col. 4, lines 45-48). This would lead one of ordinary skill in the art to search for other encapsulation means which would lead one to Ohashi and a secure encapsulation of HTML files such that hard copying of files is denied, thereby reducing the tendencies of unauthorized users obtaining classified or internal information as supported by Ohashi (col. 2, lines 10-18).

16. Claim 20 is rejected for similar reasons as stated above.

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Claims 11, 12, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan in view of Kurokawa (USPN 6,237,099).

17. Referring to claim 11, McMillan discloses the invention substantively as described in claim 1. McMillan does not specifically disclose assigning a password to the document and transmitting the password to the server computer. In analogous art, Kurokawa discloses another method of transmitting document files from a sender to a receiver wherein the sender assigns a password to the document and transmitting the password to the server computer (Figure 3, 52, 53; col. 2, lines 15-23). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kurokawa with McMillan in order to provide secure access to files and to prevent unauthorized access to documents, which is a well known security issue in computer networking.

18. Referring to claim 12, McMillan discloses the invention substantively as described in claim 1. McMillan does not specifically disclose providing a document password entry form to the receiver computer, entering a second password into the form to the server computer, and transmitting the document file from the server to the receiver when the second password matches the first password. In analogous art, Kurokawa discloses another method of transmitting document files from a sender to a receiver providing a document password entry form to the receiver computer, entering a second password into the form to the server computer, and transmitting the document

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file from the server to the receiver when the second password matches the first password (Figure 8, 90-95; col. 6, lines 31-58). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kurokawa with McMillan in order to provide secure access to files and to prevent unauthorized access to documents, which is a well known security issue in computer networking.

19. Claims 18-19 are rejected for similar reasons as stated above.

Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan in view of Day et al. (USPN 6,243,722) (hereinafter Day).

20. Referring to claim 3, McMillan discloses the invention substantively as described in claim 1. McMillan does not specifically disclose transmitting a comment file containing comments generated by the receiver from the receiver computer to the server computer, storing the comment file on the server computer, and providing the sender computer with access to the comment file. In analogous art, Day discloses another method of transmitting document files from a sender to a receiver which transmits a comment file containing comments generated by the receiver from the receiver computer to the server computer, storing the comment file on the server computer, and providing the sender computer with access to the comment file (Figure 7, 150; Figure 8, 162; col. 8, line 5 to col. 9, line 24). It would be obvious to a person of

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ordinary skill in the art at the time the invention was made to combine the teaching of Day with McMillan in order to collectively develop and modify networked-based documents, thereby reducing production time and increasing feedback upon the document.

21. Claim 22 is rejected for similar reasons as stated above.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. Lo et al. (USPN 6,212,534) discloses facilitation collaboration in connection with generating documents among a plurality of operators using networked computer systems.

24. Wang et al. (USPN 6,314,454) discloses certified email messages.

25. Greene et al. (USPN 6,802,000) discloses authenticating access to online content referenced in hardcopy documents.

26. Griebenow et al. (USPN 5,850,520) discloses electronic publication distribution including return receipt.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
November 9, 2004

William C. Vang
Primary Examiner
Art. Unit 2143
William C. Vang